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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/733,891

12/09/2000

Karim Kaddeche

998002 PA3

1840

30781

7590

12/29/2005

PHILIP K. YU

20955 PATHFINDER ROAD

SUITE 100

DIAMOND BAR, CA 91765

EXAMINER

CARLSON, JEFFREY D

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,891

Applicant(s)

KADDECHE ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 5/17/04.

Specification

2. The disclosure is objected to because of the following informalities:
 - Page 6 line 7, page 7 line 21, page 8 lines 18-20, page 9 line 27 each need correction for typographic errors.
 - Page 7 line 10, "Internet" should apparently be replaced by "user".

Appropriate correction is required.

The amendment filed 5/17/04 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: There is no support for interpolation. The specification (page 7 line 1) states interpolation.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

3. Claim 26 is objected to because of the following informalities:
 - Claim 26, "sources" should be replaced by "source".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 16, 18, 21, 22, 23, 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 16 states that delivery of the message is accomplished by connecting “said computer” (believed to be the computer housing the IP vs. location database) to a web server of a third party. No description is found in the specification that describes this and It is believed that if anything, the new visiting user is delivered an ad. Even if this is the case, the specification is devoid of any description that a new visitor “connects” to a third party server. It is unclear whether this claim intends to claim a visitation by the visitor to the third party server or a connection or a banner ad delivery.
- Claim 18, there is no antecedent basis for “receiving attributes from said visitors”.
- Claim 18, merely invoking an applet does not upload geographic information; there must be a step of user’s submitting the information.
- Claim 21 is confusing in that if a user’s geographic location can be immediately looked up, isn’t his location already known? Claim 15 requires that this user’s location not be known.

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- Claim 22, it is unclear how a cookie will let the system approximate a location for the user.
- Claim 27, there is no antecedent basis for the third party.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. **Claims 22, 23 are rejected under 35 U.S.C. 102(xxx) as being anticipated by Merriman et al (US5948061).**

Regarding claim 22, Merriman et al teaches customized advertising for web site visitors. An ad server process (19) runs on a server that is connected to the Internet and to the other machines involved [fig 1]. Visiting users are identified by IP address [5:15-16] and these identified users are presented with a generic messaging space filled by an ad chosen for them based on their profile (which includes their location) [2:19-30, 3:5-23, 4:44-55, f4:65 to 5:8, fig 3A]. The location for a new user requesting a web page and its associated generic message space (banner space) is not known by the system, yet the system determines the user's IP address [5:38-39] and subsequently will derive the user's profile [5:40-42] by querying Internet Whols databases [7:45-55] and in order to determine the address and therefore the geographic location and the

time zone to be associated with the user [7:56 to 8:1]. The user location is now known and an advertisement will be delivered to the user based upon his profile which now includes location information.

Regarding claim 23, Merriman et al teaches that upon clicking an advertising banner, the user is then connected to the advertiser's website [3:18-23]. The displayed content of such a website delivered to the user who has "clicked through" the banner is taken to read on an electronic version of a document.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 15, 16, 18, 20-22, 24, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parekh et al (US6757740) in view of Naidoo (US6629136).**

Regarding claims 15, 22, 24, applicant's claimed invention essentially consists of two parts: 1) the collection of user-submitted location information and creation of an IP vs. location database and 2) using such a database to provide geographically targeted ads. For ease of understanding, examiner will discuss the 2nd part first, then the 1st part as it relates to the applied art. Parekh et al teaches the determination of a user's location and delivery of geographically targeted advertising to the user [3:32-36]. This is accomplished by a central computer system (50) providing a database which maps IP

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addresses to geographic locations. Other websites' servers desiring to geographically target advertisers to their visitors contact this server via the Internet with a visitor's IP address and request geographic location information for that IP-identified user which is then used to deliver customized content to the visitor [figure 5, 11:30-67]. When a user whose IP address is already in the database returns to a website using such a system, the database is searched for the matching IP address, a location is identified and an appropriate geographically targeted ad is selected for the returning visitor. This is taken to read on applicant's second part of claim 1 in that such a visitor's location is not known to the web server, but perhaps to the central host computer (50). Further the locations stored by Parekh et al represent guesses and even if guesses are stored for user's IP it could be said that their location is not truly "known". Further still, if the visitor is new (his IP is not in the database), Parekh et al will associate his IP with other similar IP addresses that are in the database and consider this to be a sufficient match and the noted location is used for targeting the ad to this "new" user [10:36-49]. Parekh et al teaches that visitors without any stored location information can be associated with location information through the use of network analysis tools such as ping, traceroute, whois, etc [4:54-61]. Parekh et al states that the invention is not limited to these tools and that any system or method can be used to determine user's location [4:62-68]. Another example offered by Parekh et al is that users can submit their own location information for use in the IP vs. location database [12:44-50]. Parekh et al does not explicitly teach the use of geocoding to transform a geographic attribute to latitude and longitude coordinates. Naidoo also teaches a system where users receive location-

based advertising based upon their stored location information [abstract]. Users in Naidoo submit their address which is geocoded into a spatial coordinate system such as lat/long [2:48-60, 8:32-45]. It would have been obvious to one of ordinary skill at the time of the invention to have geocoded into lat/long coordinates the location information provided by users of Parekh et al so that user's locations can be accurately targeted with high precision. Parekh et al teaches that multiple entry conflicts can be analyzed and resolved [12:44-53, 11:1-13].

Regarding claim 16, providing location-based advertising is taken to inherently include advertising for an entity located or servicing locations within a predefined distance from the defined user location. Inclusion of a banner ad is taken to meet the connection to a third party web server. Further, Naidoo teaches that promotional notices, links to websites and telephone directory information may be delivered all of which correspond to the geographic area [3:51-58].

Regarding claim 18, Official Notice is taken that applets such as JavaScript or java-based applets are known mechanisms to request information from a user. It would have been obvious to one of ordinary skill at the time of the invention to have used any well known information request mechanism including an applet in order to request and receive the user's specified address.

Regarding claim 20, the determination of a user's location and the subsequent selection of an ad for a nearby advertiser or vendor is taken to inherently "derive...demographic information" for the user. The user is determined to be located

within the location of the advertiser/vendor. Location is taken to be demographic information.

Regarding claim 21, the users are identified by their IP address (i.e. 130.207.47.1) which is taken to be a unique string.

Regarding claim 25, interpolation and extrapolation are well known methods for determining a value when nearby data points are known. Parekh et al teaches interpolation for the confidence value of an unknown location entry when such entry is surrounded by neighboring location entries. It would have been obvious to one of ordinary skill at the time of the invention to have used interpolation in order to define the location of an unknown IP address when similar IP addresses are however known. This provides a valuable method taught by Parekh et al for gathering data about an unknown entry.

10. Claims 17, 19, 23, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parekh et al in view of Naidoo and Merriman et al.

Regarding claim 17, Parekh et al does not appear to describe subsequent communications between the user and the advertising/advertiser. Merriman et al teaches that upon clicking an advertising banner, the user is then connected to the advertiser's website [3:18-23]. This is taken to provide a secondary message to the user.

Regarding claim 19, Merriman et al teaches a user targeting profile to include IP, address, location, time zone, etc [fig 3A]. Parekh et al teaches the use of city, county,

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regional and state geographic parameters to derive the users location-based profile. It would have been obvious to one of ordinary skill at the time of the invention to have zipcode as a similar geographic parameter. Further, Naidoo teaches that zip codes are known to be used for targeting to location [2:7-10] and it would have been obvious to one of ordinary skill at the time of the invention to have used zip codes in order to profile user location. Lastly, Naidoo teaches that location based targeting may be based upon a desired geographic level such as a census tract, neighborhood, subdivision, school district, trade area, etc [3:34-37] and it would have been obvious to one of ordinary skill at the time of the invention to have also used zipcode as a similar political boundary. Naidoo teaches that the desired geographic level of the customized information may be dynamically based upon a desired geographic level responsive to a user's request for localized content or automatically based upon the subject matter of the user's requested content [3:27-41] and that the user may request content by using a zoomable map [6:41-55]. It would have been obvious to one of ordinary skill at the time of the invention to have determined (i.e. assumed) a user's location based upon the maps and zoom level (view extent) that the user requests. Lastly, Parekh et al teaches that confidence levels can be applied to the information stored in the user location profile [6:7-12, 25-48, 8:44-47].

Regarding claims 23, 27, Merriman et al teaches that upon clicking an advertising banner, the user is then connected to the advertiser's website [3:18-23]. The displayed content of such a website delivered to the user who has "clicked through" the banner is taken to read on an electronic version/message of a document.

11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parekh et al in view of Naidoo and further in view of Eldering (US6324519).

Regarding claim 26, Parekh et al does not appear to teach bidding for advertising placement. Eldering however teaches the idea of advertisers bidding to place their ads responsive to announced ad opportunities in a real-time online environment [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have used a bidding system in order to fulfill the advertising selection described by Parekh et al in order to maximize advertising revenue.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Linsk (US6138142) teaches geo-targeted ads based upon IP addresses that include embedded lat/long references. [4:4:9-24].
- Gupta et al (US6487538) teaches an IP vs. location database derived from users' ISP modem phone numbers [5:17-35, 6:10-22].
- Carney et al (US6408278) teaches an IP vs. geographic location database [4:4-11].
- The following teach other databases for IP vs. location lookups to determine location given a specific IP address:

Leslie, Jerry, "Re: Latitude/Longitude Database fpr U.S.", 11/20/1994, alt.internet.services USENET newsgroups, Message-ID: <3amu93\$249@uuneo.neosoft.com>.

Quarterman, John S., "Re: IP geographical mapping", 2/22/1997,
<http://ops.ietf.org/lists/namedroppers/namedroppers.199x/msg02617.html>.

Farrell, Craig et al, "GeoTraceMan" readme.txt and gtm_backbone_hosts.cache files dated 7/18/1995
compressed into archive named geotraceman-1.0a.tar.gz and posted at
<http://ftp.nluug.nl/security/coast/netutils/netman/sun4c>.

Silverman Stefan Jon, "Need Net Maps of Large USA Backbones", 17/16/1995, comp.protocols.tcp-ip
USENET newsgroup, Message-ID: <3u9tlo\$ir9@kadath.zeitgeist.net>.

Watanabe, Yasuhito et al, "The Design and Implementation of the Geographical Location Information
System", Proc. INET '96.

Davis, C. et al, "A Means for Expressing Location Information in the Domain Name System", January 1996,
Network Working Group, Request for Comments: 1876 (RFC1876), <ftp://ftp.rfc-editor.org/in-notes/rfc1876.txt>.


13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc